



Serial No.: 09/849,907
Confirmation No.: 9112
Applicant: NGUYEN, Van
Atty. Ref.: 12929.0061.NPUS00

REMARKS:

REMARKS REGARDING CLAIM AMENDMENTS:

The above noted amendments to the claims have been made so that the scope and language of the claims is more precise and clear in defining what the Applicant considers to be the invention. Specifically, claim 6 has been amended to reflect that the first longitudinal axis already has an antecedent basis in claim 5 and claims 5 and 17 have been further amended to more clearly reflect what the Applicant considers to be the invention. New claims 22-26 have also been added to further expand upon claimed subject matter. Support for the above amendments to claims 5 and 17, and new claims 22-28 can be found in the original specification as filed in at least the following locations:

Claim 5 Amendments	Page 8, line 29 through page 9, line 9.
Claim 17	Page 8, line 21-23.
Claim 22	Page 9, lines 10-18.
Claim 23	Page 8, line 21-23.
Claim 24	Page 8, lines 19-20.
Claim 25	Page 8, lines 19-20.
Claim 26	Page 8, line 29 through page 9, line 9.
Claims 27-28	Figures 1 and 2

The claims and amended claims are submitted as being clearly distinct and patentable over the art of record and therefore their entry and allowance by the Examiner is requested.

IN RESPONSE TO THE OFFICE ACTION:

CLAIM REJECTION 35 U.S.C. § 112:

The Examiner has rejected claim 5 under 35 U.S.C. § 112 as failing to comply with the written description requirement. Specifically, the Examiner has stated that there is no support in the originally filed specification or drawings for the phrase “within at least three directional planes of motion” and it is not inherent, implicit or explicit from the original specification as required.

The Applicant traverses this rejection—ample support is apparent from the specification. The three planes of motion comprise at least (1) rotational movement about the clamp, (2) movement along the first longitudinal axis, and (3) rotational movement about the first longitudinal axis. Of interest, the Applicant notes that the Examiner must have understood these three planes of movement as such movement was described in the § 103 rejection when the Examiner states, “Firstly, the arm is radially rotatable in a plane of motion about the first longitudinal axis with respect to the clamp...Secondly, the arm is radially rotatable about the clamp...Thirdly, the arm is axially movable along the first longitudinal axis...” Thus, Applicant cannot agree that three planes of movement are not implicitly or inherently understood by the Applicant’s specification. Nevertheless, in an effort to put this application into condition for allowance, Applicant has deleted this particular phraseology.

CLAIM REJECTION 35 U.S.C. § 103:

The Examiner has rejected claims 2, 3, 6-12, and 14-21 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,875,651 to Wergin in view of U.S. Patent No. 837,642 to Powell.

Applicant requests that the Examiner reconsider and withdraw the above rejection of the claims in view of the following.

A determination under 35 U.S.C. § 103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. *In re Mayne*, 104 F.3d 1339, 1341, 41 U.S.P.Q. 2d 1451, 1453 (Fed. Cir. 1997). An obviousness determination is based on underlying factual inquiries including: (1) the scope and content of the

prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 U.S.P.Q. 459, 467 (1966), see also *Robotic Vision Sys., Inc. v. View Eng'g Inc.*, 189 F.3d 1370, 1376, 51 U.S.P.Q. 2d 1948, 1953 (Fed. Cir. 1999).

In line with this standard, case law provides that "the consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art." *In re Dow Chem.*, 837 F.2d 469, 473, 5 U.S.P.Q. 2d 1529, 1531 (Fed. Cir. 1988). The first requirement is that a showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q. 2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." *In re Dembiczak*, 175 F.3d 994, 1000, 50 U.S.P.Q.2d 1614, 1617.

The second requirement is that the ultimate determination of obviousness must be based on a reasonable expectation of success. *In re O'Farrell*, 853 F.2d 894, 903-904, 7 U.S.P.Q. 2d 1673, 1681 (Fed. Cir. 1988); see also *In re Longi*, 759 F.2d 887, 897, 225 U.S.P.Q. 645, 651-52 (Fed. Cir. 1985). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1265, 23 U.S.P.Q. 2d 1780, 1783-84 (Fed. Cir. 1992).

The Examiner bears the burden of establishing a prima facie case of obviousness. *In re Deuel*, 51 F.3d 1552, 1557, 34 U.S.P.Q. 2d 1210, 1214 (Fed. Cir. 1995). The burden to rebut a rejection of obviousness does not arise until a prima facie case has been established. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q. 2d 1955, 1957 (Fed. Cir. 1993). Only if the burden of establishing a prima facie case is met does the burden of coming forward with rebuttal argument or evidence shift to the applicant. *In re Deuel*, 51 F.3d 1552, 1553, 34 U.S.P.Q. 2d 1210, 1214 (Fed. Cir. 1995), see also *Ex parte Obukowicz*, 27 U.S.P.Q. 2d 1063, 1065 (B.P.A.I. 1992).

Applicant's amended claim 5 recites that the "arm is movable along the first longitudinal axis and rotatably moveable about the first longitudinal axis such that the arm may be oriented to extend from a second end of the clamp, directly opposed to the first end of the clamp, while still supporting medical fluids." The Wergin et al. reference fails to disclose or suggest such limitation and therefore cannot render Applicant's invention obvious, even in combination with Powell.

The Wergin apparatus is rotatable from the horizontal position as shown in Fig. 2 of Wergin to a vertical formation such that the horizontal arm portion (12) is vertically rotated. (See column 3, lines 53-56) However, as one can readily discern, the Wergin reference does not allow for a 180-degree rotation as Applicant's embodiment clearly does. If one attempted in fact to do so, the vertical arm portion (18) would extend down to the floor. If one were to rotate the horizontal arm portion (12) about the horizontal axis in order to allow for the vertical arm portion (18) to extend upwards, the offset member (14) would then interfere with the operating table effectively preventing one from obtaining the desired positioning. Moreover, the particular configuration of the offset member 14 in Wergin is desired because upon vertical rotation "the operating table 20 will not interfere with any peripheral equipment attached to either the horizontal arm portion 12 or the vertical arm portion 18." (column 3, lines 57-61) Thus, not only does the Wergin reference fail to disclose this limitation, the Wergin reference contains no suggestion to modify its disclosure in such a manner as to render Applicant's claimed subject matter obvious.

Applicant's amended claim 17 recites "wherein the first arm portion is movable along the first longitudinal axis, the movement along the first longitudinal axis being limited by an end of the first arm portion having an increased diameter." The Wergin et al. reference fails to disclose such limitation and therefore cannot render Applicant's invention obvious, even in combination with Powell.

As disclosed by Wergin, "[i]n order to allow the vertical rotation of the horizontal arm portion 12 about the axis of bracket 30, **it is necessary to offset the axis of the horizontal arm portion 12 from the axis of the extension finger 16.**" See Column 3, lines 53-56. As shown most clearly in Fig. 2 of Wergin, the movement of the extension finger 16 limits any longitudinal



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movement of the horizontal arm portion 12 on one side of the bracket 30. As best seen in Figures 1, 2 and 4 the other end of the horizontal arm portion 12 extending from the bracket does not have an increase in diameter such that it would prevent the horizontal arm 12 from completely sliding out of the bracket 30. Moreover, there is no suggestion in Wergin to modify this feature in such a manner as Applicant's stop 43 as described on page 8 of Applicant's specification. One can readily discern the advantages of such a useful feature, in particular the safety enhancement. For example, during operation when one needs to slide the horizontal bar through the clamp to adjust the position of the apparatus, one would not need to be concerned that one could accidentally slide the entire horizontal bar out of the securely fastened clamp potentially jeopardizing the safety of the patient when undergoing intravenous therapy. The Wergin reference fails to disclose this limitation, and the Wergin reference contains no suggestion or need to modify its disclosure in such a manner as to render Applicant's claimed subject matter obvious.

Given the above, Applicant requests that the rejection of claims 5 and 17, as well as the claims depending therefrom, be reconsidered and withdrawn and that the Examiner indicate the allowance of the claims in the next paper from the Office.

The undersigned representative requests any extension of time that may be deemed necessary to further the prosecution of this application.

The undersigned representative authorizes the Commissioner to charge any additional fees under 37 C.F.R. 1.16 or 1.17 that may be required, or credit any overpayment, to Deposit Account No. 01-2508, referencing Order No. 12929.0061.NPUS00.

In order to facilitate the resolution of any issues or questions presented by this paper, the Examiner should directly contact the undersigned by phone to further the discussion.



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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michelle C. Replogle". The signature is fluid and cursive, with a long horizontal stroke at the end.

Michelle C. Replogle

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Date: 11-4-04